



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,361	07/08/2002	Andrew Heaton	07579.0016	7117
22852	7590	12/17/2002		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20006			EXAMINER	
			SACKY, EBENEZER O	
		ART UNIT	PAPER NUMBER	
		1626	8	
DATE MAILED: 12/17/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>10/070,361</b>	Applicant(s) <b>ANDREW HEATON ET AL.</b>
Examiner <b>EBENEZER SACKY</b>	Art Unit <b>1626</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jul 8, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 12-20 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 12-20 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

Art Unit: 1626

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 12, 14, 15 and 17 (in part) are, drawn to an isoflavone compound or analogues of formula (I), compositions with pharmaceutical carriers and methods of using compounds of formula (I) in treating various disease state.

Group II, claim(s) 13, 14, 15 and 17 (in part) are, drawn to an isoflavone compound or analogues of formula (II), compositions with pharmaceutical carriers and methods of using compounds of formula (II) in treating various disease state.

Art Unit: 1626

Group III, claim(s) 16 is, drawn to an agent.

Group IV, claim(s) 18 is, drawn to food-stuff or drink which contain compounds of formula (I and II).

Group V, claim(s) 19 is, drawn to a microbial culture or food-stuff which contains compounds of formulae (I and II).

Group VI, claim(s) 20 is, drawn to microorganisms which produce one or more of the compounds of formulae (I and II).

#### **LACK OF A SPECIAL TECHNICAL FEATURE**

2. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the claims herein lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The substituents on formulae (I) and (II) vary extensively and when taken as a whole result in vastly different compounds and compositions. Accordingly, unity of invention is considered to be lacking and a restriction of the invention in accordance with the rules of unity of invention is considered

Art Unit: 1626

to be proper. Moreover, to not restrict herein, would impose a burden on the examination of this application. Illustrate of different inventive concepts may be made by reference to the compounds in the Examples of the instant application, as for example, the compounds of

- I. Example 1
- II. Example 8
- III. Example 9
- IV. Example 15

Applicant is required to elect a single disclosed species (e.g., Example) from under the instant claims. With the election of a specific exemplified compound, a generic concept, including the corresponding composition will be identified by the Examiner as the inventive group for examination.

3. A telephone call was made to Robert Mann on 11/19/02 and 11/25/02 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this

Art Unit: 1626

requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (703) 305-6889. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Art Unit: 1626

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

EOS

December 10, 2002

(fm)

Joseph K. McKane

Supervisory Patent Examiner

12/14/02

Art Unit 1626, Group 1600

Technology Center 1